

Application No. 10/692,545  
Amendment dated January 17, 2006  
Reply to Office Action of January 10, 2006

### **REMARKS**

Applicant amended claims 50, 52, 53, 56, 58, 59, 65, 71, 72, 76, 93, and 99, and added new claims 105-120 to further define Applicant's claimed invention. New claims 105-120 are supported at least by page 35, line 30 to page 36, line 7 of the specification, and Fig. 11D.

In the Office Action, the Examiner rejected claims 50-52 and 54-57 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,029,573 to Chow ("Chow"). Independent claim 50, as now amended, recites an instrument with an elongated handle having a length and a height, "the length of said handle being the maximum dimension of said handle," where the longitudinal central axis of the shaft extends "through the height of said handle." The longitudinal central axis of the shaft in the Chow instrument extends along the length of the instrument, not through the height of the handle as recited in claim 50 of Applicant's claimed invention. (See Chow, Fig. 23). Applicant submits that the rejection of independent claim 50 under 35 U.S.C. § 102(b) as being anticipated by Chow has been overcome and that claims 51, 52 and 54-57, dependent from claim 50, are patentable at least due to their dependency from an allowable independent claim.

The Examiner rejected claims 50-54 under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as being obvious over Chow in view of American V. Mueller (Neurosurgical Instrument, page 989) ("Mueller"); and rejected claims 55-104 under 35 U.S.C. § 103(a) as being unpatentable over Chow in view of Mueller. Applicant respectfully traverses the Examiner's rejections for at least the reasons stated below.

#### **I. Chow and Mueller are non-analogous art.**

Chow teaches a system and method suitable for "the endoscopic release of the carpal ligament." (Chow, abstract, lines 1-8). Mueller shows instruments designed to drill into the skull for neurological surgery. (Mueller, page 989). Applicant submits that the fields of neurology and endoscopic carpal surgery are non-analogous fields of endeavor and therefore cannot be combined to arrive at Applicant's claimed invention.

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(See MPEP § 2141.01(a), "Analogy in the mechanical arts," page 2100-123, cols. 1 and 2 (May 2004), which discusses *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992) ("The court held the reference was not within the field of Appellant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments."). Applicant submits that a person of ordinary skill in the art of endoscopic carpal surgery would not look to skull drills in attempting to solve a problem in carpal surgery. Likewise, Applicant submits that a person of ordinary skill in the art of neurology would not look to instruments used for manipulating or cutting ligaments to solve a problem in neurosurgery when the skull does not contain ligaments. Accordingly, Applicant submits that the rejection is unsustainable and must be withdrawn.

Moreover, Applicant submits that Chow and Mueller are each non-analogous art to the subject matter of Applicant's claimed invention. The claims of the present invention recite an instrument, system or apparatus "for use in spinal surgery." Applicant respectfully submits that a person of ordinary skill in the art of spinal surgery would not look to skull drills or instruments for ligament surgery in order to solve a problem in the spinal field. Accordingly, Applicant submits that the rejection is unsustainable and must be withdrawn.

**II. The motivation used by the Examiner to support the combination of Chow and Mueller is not suggested by the prior art.**

Applicant further respectfully submits that the Examiner's asserted motivation for including the handle of the skull drill of Mueller on the cutting instrument of Chow "in order to provide a better gripping portion" (Office Action, page 4, paragraph 3) is not suggested in either Chow or Mueller. (See MPEP § 2143.01, "the Prior Art Must Suggest the Desirability of the Claimed Invention," page 2100-129, col. 2 (May 2004)). Accordingly, Applicant submits that the combination of Chow and Mueller cannot be maintained.

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**III. The proposed combination still does not yield Applicant's claimed invention.**

Even, *assuming arguendo*, the combination of Chow and Mueller could be properly maintained, the combination still fails to yield Applicant's claimed invention. Independent claim 58, as now amended, recites a surgical instrument with a cylindrical portion between the shaft and the handle, "said cylindrical portion having a maximum height parallel to the longitudinal central axis of said shaft and a diameter transverse to the longitudinal central axis of said shaft, the diameter of said cylindrical portion being greater than the maximum height of said cylindrical portion." Neither Chow nor Mueller, whether alone or in proper combination, teach or suggest a surgical instrument as recited in claim 58 of Applicant's claimed invention.

Independent claim 65, as now amended, recites a system including a cannula and a surgical instrument, the instrument "having a length along said shaft that is greater than the length of said cannula." Neither Chow nor Mueller, whether alone or in proper combination, teach or suggest a surgical instrument as recited in claim 65 of Applicant's claimed invention.

Independent claim 99, as now amended, recites an apparatus including a tubular member and a bone displacement device, the bone displacement device "having a length along said elongated portion that is greater than the length of said tubular member." Neither Chow nor Mueller, whether alone or in proper combination, teach or suggest an apparatus as recited in claim 99 of Applicant's claimed invention. Applicant submits that the rejection of independent claim 50 and dependent claims 51-54 under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as being obvious over Chow in view of American V. Mueller (Neurosurgical Instrument, page 989) ("Mueller"); and the rejection of independent claims 58, 65, 93, and 99, and dependent claims 55-57, 59-64, 66-92, 94-98, and 100-104 under 35 U.S.C. § 103(a) as being unpatentable over Chow in view of Mueller have been overcome.

Applicant submits that independent claims 50, 58, 65, 93, 99, and 109 are patentable and that dependent claims 51-57, 59-64, 66-92, 94-98, 100-106, and 110-

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120 dependent from one of independent claims 50, 58, 65, 93, 99, and 109, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1068.

Respectfully submitted,

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Dated: January 17, 2006

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